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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,704	09/19/2005	Akihiro Kuroda	5521-0116PUS1	7682
2292 7590 12/04/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
GULLEDGE, BRIAN M				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
12/04/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/549,704

Applicant(s)

KURODA ET AL.

Examiner

Brian Guldged

Art Unit

1612

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 3-5, 12, 13, 15, 16, 23 and 25-29.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Brian Guldged/
Examiner, Art Unit 1612

/JEFFREY S. LUNDGREN/
Primary Examiner, Art Unit 1639

Continuation of 5. Applicant's reply has overcome the following rejection(s): the rejection of claims 12-13 and 25-29 under 35 USC 112, second paragraph has been withdrawn in view of the amended claims.

Continuation of 11. does NOT place the application in condition for allowance because: the Examiner is not persuaded by the arguments presented.

The Applicant traverses the rejections of the claims previously presented under 35 USC 103. For claims 1, 3-5, 15-16, and 23, the Applicant argues that the rejection is not proper as Jose et al. does not recognize the unexpected and superior properties the Applicant has demonstrated when combining the siloxanes of formula (1) and (2). For claims 12-13 and 25-29, the Applicant argues that Auguste does not recognize the unexpected superior effects of the combination of the siloxane of formula (1) with polybutene.

The Examiner is not persuaded by the evidence cited by the Applicant. With regards to claims 1, 3-5, 15-16, and 23, the Applicant argues that the example present in the specification demonstrate that the combination of tetraquistrimethylsiloxysilane (formula (1)) and methyltrimethicone (formula (2)) shows superior performance in the categories of "no irritation to the skin," "comfortable to apply," "suitable as a cosmetic base," and "no straining after applied." The pertinent examples are examples 11, 12, 16-23 and comparative examples 22 and 23. Examples 11 has both the compound of formula (1) and formula (2), whereas example 12 only differs in that the compound of formula (1) is replaced with more of compound formula (2). These examples, when evaluated by the Applicant for the above four properties, gave identical outcomes with regards to "no irritation to the skin," "suitable as a cosmetic base," and "no straining after applied." Thus, the combination of the two compounds (as opposed to the use of just the compound of formula (2)) is not shown to be important for these properties: removal of one of the two ingredients of the claimed combination had no effect on three of the properties. As for the last property tested, "comfortable to apply," there was a difference between the two examples. However, examples 20-23 suggest that the combination of siloxanes is not the controlling factor for this property. These examples are sunscreens that were also tested, and examples 20 and 21 have the combination of the compounds of formula (1) and (2), whereas examples 22 and 23 only have the compound of formula (1) present. However, these have essentially the same "comfortable to apply" property, and are also similar to example 11.

As for claims 12-13 and 25-29, the Examiner is not persuaded. The data provided compares lipstick formulations (examples 7-8 and comparative examples 7-9). All of these examples are anhydrous, contain 17 wt% pigment, at least 8 wt% of each oily agent, and do not contain a polyol or a surfactant. However, Claim 13 (and dependent claims 27 and 29) recite limitations to all of these ingredients that place all of the tested examples outside the scope of the invention as recited. To be of any probative value, any secondary evidence must be related to the claimed invention. Here, there is no nexus established between the howing and the invention as claimed, as they are mutually exclusive in scope. See MPEP 716.01(b). Claim 28 recites the inclusion of a UV-ray protective compound, and none of the examples discussed have such a compound present. And claim 25 recites a limitation to the molecular weight of the polybutene, and the molecular weight of the polybutene used in the examples was not provided, so the Examiner is unable to determine if the required nexus exists.

As for claim 12, the data is not found persuasive. The examples compare a lipstick with the siloxane of formula (1), (2), and polybutene. Example 7 has all three compounds. Comparative examples 7 and 9 replaces the compound of formula (1) with a generic siloxane (cyclic pentamer and linear polysiloxane, respectively), and comparative example 8 replaces the polybutene with ceresin. Only example 7 was evaluated as an "A" in the tested categories (better grade than "D"). Thus, the examples showed that both the compound of formula (1) and the polybutene are required to have the desired effect. While this effect is not taught or expected by Auguste et al., the data is still not found persuasive, as once unexpectedness has been established, the probative value of the evidence as compared to the invention as claimed must be determined, i.e., claims must be "commensurate in scope" with the showing. See MPEP 716.02(d). And the showing is not found commensurate in scope with the claims. The examples include a third trimethylsiloxo species, and the claims do not, and it is possible that this plays a role in the properties (i.e., the combination of three ingredients is important. Also, the claims recite broad ranges for the amounts of these ingredients, and the examples only demonstrate the effect for one amount. Additionally, the claims are not limited with regards to the other species present or the form of the cosmetic. The examples were all lipsticks, but the claims are drawn simply to oil-based cosmetics, and thus do not even need to be solid.